

## **REMARKS**

Claims 1-24 are currently pending of which Claims 5, 7, 9, 17, 19, and 21 are withdrawn (and are now formally canceled in order to further the prosecution). The Examiner has provided both rejections and objections to the remaining claims that are addressed in the following order.

- I. Claims 1, 11, 13, and 23 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite.
- II. Claims 1, 4, and 11 are rejected under 35 USC 102(b) as allegedly being anticipated by Yang et al., *Develop Dynamics* 216:2-9 (1999).
- III. Claims 13, 16, and 23 are rejected under 35 USC 103(a) as allegedly being unpatentable over Yang et al., *Develop Dynamics* 216:2-9 (1999) in view of *United States Patent No. 5,175,343* To Fitzberg et al.
- IV. Claims 2, 3, 6, 8, 10, 12, 14, 15, 18, 20, 22, and 24 are objected to as allegedly being dependent upon a rejected base claim.

### **I. The Claims Are Not Indefinite**

The Examiner believes that “The claims as written are ambiguous because of the term ‘derived from MMP9’ (see, for example, claims 11 and 23). *Office Action, pg 3 para 6*. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 11 and 23. These cancellations are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner further believes that “... it is unclear what peptide Applicant is claiming that is compatible with the instant invention since a peptide may have only two amino acids”. *Office Action, pg 4 para 6*. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 1 and 13 to recite four specific amino acid sequences related to the MMP family (i.e., from non-withdrawn claims 6 & 18, 8 & 20, 10 & 22,

and 12 & 24) which have been concomitantly canceled. Withdrawn Claims 5, 7, 9, 17, 19, and 21 are also canceled because the Applicant believes the remaining claims are in condition for allowance. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request that the Examiner withdraw the present rejection.

## **II. The Claims Are Not Anticipated**

As the Examiner is well aware, a single reference must disclose each limitation of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with the Yang et al. reference.

The Examiner states that Claims 1, 4, and 11 are rejected as allegedly anticipated under Yang et al. because this reference supposedly teaches a method of treating a wound by administering an MMP prodomain peptide derived from MMP-9. The Applicants disagree and point out that Yang et al. does not disclose the amino acid sequence Ac-PRCGVPDLGRFQ-NH<sub>2</sub> (as well as the other three amino acid sequences, as currently amended). Consequently, Claim 11 is not anticipated. Further, due to the above claim amendments to Claim 1, the Examiner's rejection to Claim 1, and therefore Claim 4 also, are moot.

The Applicants respectfully request that the Examiner withdraw the present rejection.

## **III. The Claims Are Not Obvious**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP* § 2142; Establishing A *Prima Facie* Case Of Obviousness. The Examiner is reminded that if ONLY ONE of the above requirements is not met, then a *prima facie* case of obviousness does not exist. The Applicants submit that the Examiner's rejection does not meet these criteria. The Applicants rebut the establishment of a *prima facie* case of obviousness by the argument below.

The Examiner attempts to make a reference combination using Yang et al. and Fitzberg et al. to reject Claims 13, 16, and 23 as allegedly obvious. As explained above, Yang et al. does not contain all the elements of Claims 13, 16, and 23 because Yang et al. fails to teach the Ac-PRCGVPDLGRFQ-NH<sub>2</sub> amino acid sequence (as well as the other three amino acid sequences, as currently amended). Fitzberg et al. also does not disclose these sequences<sup>1</sup>. Consequently, both references fail to teach all the claimed elements within the current embodiment. Therefore, the asserted obviousness rejection fails.

The Applicants respectfully request that the Examiner withdraw the present rejection.

#### **IV. The Claims Are Allowable**

Applicants note appreciatively that Claims 2, 3, 6, 8, 10, 12, 14, 15, 18, 20, 22, and 24 are objected to as allegedly being dependent upon a rejected base claim but would be allowable if rewritten in independent form. The Applicants point out that Claims 6, 8, 10, 12, 18, 20, 22, and 24 were concomitantly canceled due to the above claim amendments to Claims 1 and 13. The above amendments to Claims 1 and 13 place these independent claims in condition for allowance.


The Applicant respectfully requests that the Examiner withdraw these objections.

### **CONCLUSION**

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned collect at 617.984.0616.

Date: April 25, 2007

By: \_\_\_\_\_

  
Thomas C. Howerton  
Reg. No.: 48,650

Medlen & Carroll, LLP  
101 Howard Street, Suite 350  
San Francisco, CA 94105  
617-984-0616

---

<sup>1</sup> The Applicants also argue the Fitzberg et al. is non-analogous art. There are many reasons, for example, Fitzberg et al. does not solve any problems related to wound healing and is not related to the field of matrix metalloproteinases.